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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,803	08/18/2000	Toshiaki Kubo	2870-0143P	7282

7590 04/08/2003

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EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 04/08/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

MS-4

**Office Action Summary**

Application No.

09/640,803

Applicant(s)

KUBO, TOSHIAKI

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: see the term "(w)herein the w% is relative to the weight of the weight of the first outermost layer and the second outermost layer added together".

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fails to provide support for the language "(w)herein the w% is relative to the weight of the weight of the first outermost layer and the second outermost layer added together" in claim 1 and 7. Nowhere in the specification disclose that this weight is based on the total weight of both layer, and therefore, this language constitutes new matter to the specification.

The specification on page 2 discloses that "the binder containing in the outermost layer and binder contained in the outermost layer on the opposite site of the support have common monomer composition to a degree less than 75 % by weight; on page 59,

Art Unit: 1752

second paragraph, it is disclosed that "adhesion improper for the practical use was observed for thermally process image forming material in which 75 w% or more of the composition binder is common for the outermost layers on both plane. Thus, the specification as a whole appear to be related to "the degree less than 75 wt%" which is the weight of the monomer forming the polymeric binder such as polymer latex, rather than the weight % of the common binder or common monomer relative to both outermost layer.

Also, claiming of "the binder containing in the first outermost layer on the first side contains a polymer latex in the amount of 50 w% or more of the total binder contained in the first outermost layer on the first side and claiming of "the binder containing in the second outermost layer on the second side contains a polymer latex in the amount of 50 w% or more of the total binder contained in the first outermost layer on the second side" raises the issue of new matter since the specification as originally filed fails to provide support for "and", but "or". Therefore, the use of the language "and" that has not been presented at the time of filing also raises the issue of new matter.

The applicants assert that many any examples satisfy the conditions set forth in claim 1 such as samples 1-2 to 1-7 in Table 1, and Samples 2-2 to 4-6 in Table 4.

The argument is not persuasive. There is no statement showing that the polymer latex in the amount of 50 wt% or more of the total binder shown in the Tables in the argument, and the applicants fails to clearly demonstrate such an assertion. Second, in Table 1 is related to the showing of the relationship of second outermost layer on with

Art Unit: 1752

respect to the monomer composition, wherein the combination of different monomer was used therein.

The specification fails to clearly describe as how to determine the "common monomer to the degree less than 75 wt% for the present claimed invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claiming of "the wt % is relative to the weight of the first outermost layer and the second outermost layer added together" in claim 1 and 7 is indefinite" as it is unclear as the mete and bound of the weight of the first outermost layer and the second outermost layer cannot determined form the specification and the claimed invention, and the term "relative" is vague and indefinite. The term "common monomer" is unclear since the specification fails to provide the mete and bound thereof and moreover, terms cannot be used when given meanings which are repugnant to their usual meanings. In re Barr 170 USPQ 330 (CCPA 1971); In re Hill 73 USPQ 482 (CCPA 1947). . In this case, the term "common" is contradict with the usual meaning such as familiar and popular ect... Futhermore, the scope of protection sought for the "common monomer" is vague and indefinite as it is unclear whether the monomer is in common in term of chemical structure, physical properties or other chemical characteristic.

Art Unit: 1752

Claims 4-10 are unclear due to the languages used therein are inconsistent with the language presented in claim 1 such as "opposite side of the support" or 'same side of the support" . Note to the languages used in claims 4-10 vs claim 1 such as first side or second side of the support.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea *tlm*  
April 3, 2003

*Thorl Chea*  
Thorl Chea  
Primary Examiner  
Art Unit 1752